IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Bhavesh Mehta, et al.	Confirmation No.: 4272
Serial No.: 10/648,599	Group Art Unit No.: 3622
Filed on: August 25, 2003	Examiner: Jeffrey D. Carlson

For: SELECTING AMONG ADVERTISEMENTS COMPETING FOR A SLOT ASSOCIATED WITH ELECTRONIC CONTENT DELIVERED OVER A NETWORK

Via EFS-Web
Commissioner for Patents
P. O. Box 1450
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The Examiner made a clear factual error in alleging that it would have been obvious to modify U.S. Patent Application 2002/0128904 to Carruthers et al. ("*Carruthers*") to add to *Carruthers* the many express features of Claim 21 and 30 that are conceded to be entirely missing from *Carruthers*.

1. *It would not have been obvious to modify* Carruthers *to accept the recited second contract*

Claims 21 and 30 recite, in part:

> after accepting a first contract with a first advertiser, accepting a second contract with a second advertiser;
>
> wherein the delivery obligations associated with the second contract are such that fulfillment of the second contract would likely prevent the delivery obligations associated with the first contract from being fulfilled....

While the Office Actions have focused on what *Carruthers* teaches, they fail to address how those teachings satisfy the claim limitations. For example, in contrast to these express limitations, *Carruthers*' system never accepts a "second contract" whose fulfillment "would likely prevent the delivery obligations associated with the first contract from being fulfilled." The **whole purpose** of *Carruthers*' estimator (Capacity Forecaster 52, the description of which

comprises a majority of the Detailed Description) is to predict the success of fulfilling the delivery obligations of an ad campaign proposed by an advertiser (see paragraph 28). If Capacity Forecaster 52 predicts that the delivery requirements of an ad campaign will not be fulfilled, then Capacity Forecaster 52 assists the advertiser in changing the requirements of the ad campaign, such as increasing the campaign length, reducing the number of requested impressions, or relaxing the profile constraints (see paragraph 29). Thus, the purpose of *Carruthers*' Capacity Forecaster 52 would be **defeated** if Capacity Forecaster 52 is modified to accept a contract whose fulfillment would likely prevent fulfillment of the delivery obligations associated with a previously-accepted contract. It is clear error to hold that it would have been obvious to change the **fundamental behavior** of Capacity Forecaster 52 in a manner that defeats the entire purpose of Capacity Forecaster 52.

The Final Office Action asserts that *Carruthers*' system may be modified to accept "late-arriving" advertisers and that such "advertisers would only be served if ad inventory…was plentiful enough to fully serve the advertisers who came before them" (page 2). There are a number of problems with this assertion. First, the legal standard is not whether something **may** be modified, but whether it would have been obvious to one skilled in the art to perform the modification. Second, if this proposed modification were implemented, then *Carruthers*' system would have to significantly change in order to have two different types of advertisers: (1) "guaranteed" advertisers whose ad campaigns would be protected from late-arriving advertisers, and (2) "late-arriving" advertisers whose ads will only be displayed if there is extra "inventory" or screen space. Thus, Capacity Forecaster 52 would **not** perform the same function after this proposed modification. According to MPEP § 2143(A), the fact that the function of the prior art would have to be fundamentally modified is evidence of the claim limitation's non-obviousness.

Additionally, *Carruthers* **already proposes** multiple solutions for the situation in which there is extra "inventory." For example, paragraph 75 states that a set of default or filler impressions will be displayed when there is no content available for a given user. As another example, paragraph 77 states that *Carruthers*' system will "increase the likelihood of over-delivery (i.e., delivering a greater number of impressions than requested by an advertiser), which is typically favorable to advertisers." Thus, one of ordinary skill in the art at the time of

the claimed invention would not be motivated to pursue a solution to a problem for which multiple solutions have already been considered and deemed sufficient.

2. *It would not have been obvious to modify* Carruthers *to select, in response to a request for electronic content, a first advertisement over a second advertisement even though the second advertisement is associated with a greater behindness value than the first advertisement*

Claims 21 and 30 recite, in part:

> after the plurality of contracts have been formed, receiving, from a user, a request to provide over said network a piece of electronic content that includes a slot for an advertisement;
>
> ...
>
> in response to receiving the request:
>
> ...
>
> wherein the second contract is associated with a behindness value that is currently greater than a behindness value associated with the first contract,
>
> wherein the behindness value of each contract reflects how far behind a content provider is on satisfying the delivery obligations associated with each contract....

Carruthers teaches an approach where "if an advertisement gets behind in meeting its goals, it may be automatically promoted in priority" (see paragraph 35). This is in **direct contrast** to the portion of Claims 21 and 30 quoted above that a first advertisement is selected before a second advertisement even though the second advertisement is associated with a greater behindness value than the first advertisement. The Final Office Action asserts that "ad campaigns of late coming advertisers may be accepted into the system, but would be given lower priority (i.e., placed toward the end of the queue) than earlier-arriving advertisers, even if the latecomers had ad contracts which were more 'behind schedule.'" There are a number of problems with this assertion.

First, it is unclear to what queue the Final Office Action is referring. *Carruthers* discloses two queues or lists: (1) a master list of advertisements generated by Inventory Manager 51 and provided to On-Demand Scheduler 70 and (2) an individualized list constructed by On-Demand Scheduler 70 based on the master list and for a particular user when

the particular user logs onto the system. It does not make sense that advertisements from "late-comer" advertisers would be in either the master list or the individualized list. If that were so, then "guaranteed" advertisers might not have the goals of their respective ad campaigns fulfilled.

According to paragraph 35 of *Carruthers*, "if an advertisement gets behind in meeting its goals, it may be automatically promoted in priority." Thus, the *Carruthers* system treats all ad campaigns the same once they are accepted. If an advertisement "gets behind," then *Carruthers* will promote that advertisement. If multiple advertisements "get behind," then they will all be promoted. Thus, all ad campaigns might be, e.g., 98% fulfilled. Clearly, *Carruthers* **already considers** the potential problem of advertisements getting behind and implements a solution that *Carruthers* deems sufficient. One of ordinary skill in the art would not consider modifying *Carruthers* to add yet another solution to a problem already addressed and solved by *Carruthers*.

Secondly, the selection of the recited first advertisement over the recited second advertisement is performed **in response to a request for electronic content that includes a slot for an advertisement**. In contrast, *Carruthers* teaches that a master list and an individualized list are generated **prior to** any request for electronic content. Rather, the master list is generated before a user logs on and the individualized list is generated in response to the user logging on.

3. It would not have been obvious to modify Carruthers *to incorporate the slot-based approach of Claims 21 and 31*

Claims 21 and 30 recite that electronic content includes a slot for an advertisement and that the subject of the electronic content is an attribute of the slot. In response to receiving a request for the electronic content, slot attributes of the slot are compared with delivery criteria of a plurality of contracts to determine a subset of advertisements which qualify for inclusion in the slot. This is referred to hereinafter as the "slot-based approach."

Carruthers' system generates an individualized list of advertisements for a particular user that logs on by comparing the profiles of advertisements (i.e., the alleged delivery criteria) in the master list with the profile of the particular user. The Final Office Action points to a related application of *Carruthers* (i.e., U.S. Application Serial No. 09/558,755) that states that a user's profile may be based on "the current Web browsing session." However, this teaching

fails to teach or suggest that a web page that the user is viewing has a slot in which an advertisement may be inserted. Even if *Carruthers* included this teaching, *Carruthers* fails to teach or suggest that the attributes of the slot are compared to the delivery criteria of a plurality of contracts, as Claims 21 and 30 require. Rather, *Carruthers* states that the individualized list is generated when a user logs on and is not modified during the user's session. If the content of the webpage dictated the advertisements that would be delivered to a particular user, then *Carruthers*' individualized list would be **worthless**. Therefore, the individualized list aspect of *Carruthers* cannot be combined with the recited slot approach.

Furthermore, one reason why *Carruthers* estimation approach can be relatively accurate is because *Carruthers* takes into account only what is known about users at a particular time, such as which sites the users have visited and how long the users have been logged on. *Carruthers* does **not** need to know what users will be viewing in the future, which is very difficult to predict. For example, even if is it known that user A frequents sports websites, user A could look at nothing but politics sites during a particular session due to a recent, significant political event. Although it may be preferable to deliver advertisements to users who are viewing webpages that share the same subject matter as the advertisements, such a change could not have been made without **significantly altering** *Carruthers*' Capacity Forecaster 52. In fact, it is unclear what new factors and equations would have to be taken into account by Capacity Forecaster 52. Simply asserting that it would have been obvious for *Carruthers* to employ the slot-based approach of Claims 21 and 30 is much different than describing how *Carruthers* system would have to change. Because it is unclear how *Carruthers*' Capacity Forecaster 52 would have to change in order for *Carruthers*' system to incorporate the slot-based approach (about which the Final Office Action is silent), it would not have been obvious to so modify *Carruthers*.

CONCLUSION

Applicants request that the rejection of all the pending claims be reversed.

Respectfully submitted,
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